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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,990	10/17/2006	Keith Baker	NL 040413	7915

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EXAMINER

DANIELSEN, NATHAN ANDREW

ART UNIT	PAPER NUMBER
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2627

MAIL DATE	DELIVERY MODE
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03/19/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,990	Applicant(s) BAKER, KEITH	
	Examiner Nathan A. Danielsen	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 5-9 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-12 are pending.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered.

Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Specification

3. The disclosure is objected to because it lacks appropriate section headings (note the following).
Appropriate correction is required.

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4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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Claim Objections

5. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 1 claims an optical data storage medium comprising a first disc and a second disc. However, claim 10 merely claims either the first disc or the second disc without further limiting the first disc, the second disc, or the optical data storage medium.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's specification fails to set forth the details of how one of ordinary skill in the art could make a device into which the claimed "at least one of said first disc and said second disc" (meaning the optical data storage medium could also be inserted) can be inserted, positioned, rotated, or separated. Specifically, even though one of ordinary skill in the art would understand the basics of optical data storage media insertion and positioning (e.g. trays, surface loading, edge loading, etc.) and rotation (e.g. using a spindle motor with a turntable and clamping/chucking means), one of ordinary skill in the art would not have known, even reading applicant's specification (page 5, lines 11-19; which is nearly identical in language and scope to claims 11 and 12 and only offers additional motivation for making this device), how these well-known features in the optical data storage media handling art would have to be modified to insert, position, and/or rotate the claimed optical data storage media (including the first and second discs), how to make "means for separating the first disc and

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the second disc from each other”, or how to modify the aforementioned well-known features to accommodate said “means for separating the first disc and the second disc from each other”.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gudesen et al (US Patent 6,084,850; hereinafter Gudesen).

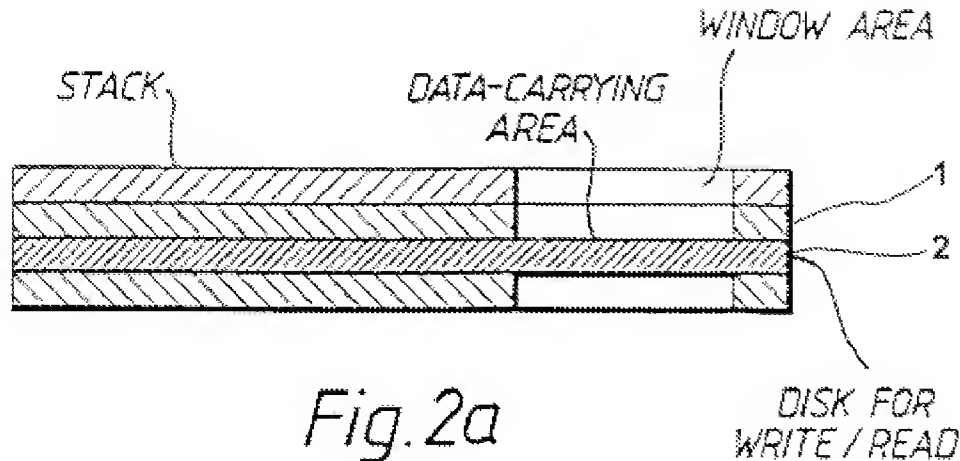
Regarding claims 1 and 10, Gudesen discloses an optical data storage medium (figure 2) comprising:

a first disc (element 1 in figure 2a, as shown on the next page) and a second disc (element 2 in figure 2a, as shown on the next page) both having an access surface (the surface of element 2 exposed to the optical read/write device of col. 5, line 67 through col. 6, line 1 on the side of the data carrying area from which light is irradiated by the optical read/write device) and a storage layer covered by the access surface (col. 6, lines 25-27), wherein the storage layer is adapted to be accessed by a laser beam via the access surface (implied by the structure disclosed in col. 6, lines 30-39 in that “high area density for the storage” would require the use of “sharp focusing of a laser beam” (see col. 1, line 65 through col. 2, line 2)), characterized in that the first disc and the second disc are adapted to be attached to each other in such a way that the access surface of the first disc covers the access surface of the second disc (the surface of element 2 “covers” the surface of element 1, as shown on the next page, where “cover” has been interpreted to mean “to hide from view; screen”

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(definition 6 found at dictionary.com 09 March 2010

(http://dictionary.reference.com/browse/cover))).



Regarding claim 11, Gudesen discloses everything claimed, as applied to claim 1. Additionally, Gudesen discloses a device for reproducing information from or recording information into at least one storage layer of an optical data storage medium according to claim 1 (col. 5, lines 47 through col. 6, line 39), comprising:

means for inserting at least one of the first disc and the second disc into the device (inherent in col. 5, lines 47 through col. 6, line 39 for placing the data carrying medium in a position that the optical read/write device can read/write data from/on the data carrying medium),

means for positioning and rotating at least one of said first disc and said second disc such that the at least one storage layer is readable by the laser beam ("manoeuvring device" in col. 6, lines 9-15).

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudesen, in view of Shultz (US Patent 6,307,830).

Regarding claims 2-4, Gudesen discloses everything claimed, as applied to claim 1. However, Gudesen fails to disclose where:

the first disc has a cavity in the access surface adapted to receive the access surface of the second disc;

the cavity of the first disc has an edge corresponding to an edge of the access surface of the second disc; and

the edge of the cavity of the first disc and the edge of the access surface of the second disc both constitute circles having the same diameter.

In the same field of endeavor, Shultz discloses where:

the first disc has a cavity in the access surface adapted to receive the access surface of the second disc (element 42 in figures 7-9);

the cavity of the first disc has an edge (bottom portion of element 42 in figures 7-9) corresponding to an edge of the access surface of the second disc (tip portion of element 40 in figures 7-9); and

the edge of the cavity of the first disc and the edge of the access surface of the second disc both constitute circles having the same diameter (note the shape of element 42 in figure 7 in combination with the structural relationship between elements 40 and 42 in figure 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the medium of Gudesen with the structure of Shultz, for the purpose of

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protecting the access surfaces of at least one recording medium in a stack of recording media (col. 2, lines 28-37).

Allowable Subject Matter

12. Claims 5-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, either alone or in combination, fails to teach or fairly suggest:

- a. In claim 5: "wherein the first disc comprises a column perpendicularly protruding from the access surface of the first disc and wherein the second disc comprises a surface opposite to the access surface and a hole for receiving said column, said hole extending from the access surface to the opposite surface of the second disc", in combination with all the limitations of the claim(s) from which it depends; and
- b. Claims 6-9 are contain allowable subject matter based on their dependence, either directly or indirectly, from claim 5.

Relevant Prior Art

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- c. Liu (US Patent 6,901,600) discloses a protective cover for a data storage disc comprising elements which protrude through a hole in the center of the data storage disc, but does not disclose at least "wherein the first disc comprises a column perpendicularly protruding from [its] access surface" and "means for separating the first disc and the second disc from each other";
- d. Hoyle (ups 6,449,124) discloses a recording medium which, when stored, has a first portion which covers a second portion, which portions can be separated for storage and attached for recording/reproducing operations, but does not disclose at least a device comprising "means for separating the first disc and the second disc from each other"; and

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e. Chen (US Patent 7,363,639) discloses an apparatus for attaching one recording medium to another and locking them in place with respect to each other, but does not disclose at least "wherein the first disc comprises a column perpendicularly protruding from [its] access surface" and "means for separating the first disc and the second disc from each other".

Closing Remarks/Comments

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A. Danielsen whose telephone number is (571)272-4248. The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan A. Danielsen/
Examiner, Art Unit 2627
03/09/2010